

## **REMARKS**

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

The Examiner rejected claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Hanai et al., U.S. Pat. Pub. No. 2006/0085282 in view of Yankovich et al., U.S. Pat. Pub. No. 2003/0110443. The Examiner's rejection is traversed for the following reason.

Applicant notes that claim 3 has been amended and claims 1, 2, 4, 5, 7, and 8 have been cancelled. Thus, claims 3, 6, and 9 remain pending.

In regards to claim 3, Applicant notes that claim 3 has been amended to include an additional feature of a means for identifying an input from the user terminal device.

Thus, Applicant discloses a combined equipment selection system that includes multiple user terminal devices and a host computer. Each terminal device includes an operation section and a display section. The terminal devices and the host computer are connected to a communication network such that the host computer communicates with the terminal devices to obtain user information.

The combined equipment selection system receives service equipment information from a user via the operation section of the terminal device on a piece of service equipment that the user wishes to use. The user then selects at least one other combined equipment that is different from the service equipment and is

suitable for being combined with the service equipment based on the service equipment information. The selection information on the combined equipment is displayed on the display section of the user terminal device.

Each user terminal device includes a means for storing the user information entered from the operation section, a means for storing constant data regarding the service equipment and the other combined equipment, a means for storing variable data out of data necessary for selecting the combined equipment, transmitted from the host computer via the communication network, a means for receiving and updating the variable data from the host computer on the condition that the user information is transmitted to the host computer, a means for carrying out a selection operation which selects as the selection information at least the one other combined equipment that is different from the service equipment and is suitable for being combined with said service equipment, based on model information and operational conditions of the service equipment entered from the operation section. Each user terminal further includes a means for requesting a display permission from the host computer for displaying the selection information selected by the means for carrying out the selection operation onto the display section on the condition that the selection information is transmitted to the host computer, and displaying the selection information onto the display section when the display permission is obtained from the host computer.

The host computer includes a means for storing the user information obtained from the user terminal device and the selection information, a means for identifying an input from the user terminal device, and a means for transmitting updated variable data to the user terminal device when the means for identifying the input

from the user terminal device identifies that only the user information is entered from the user terminal device, or transmitting the display permission to the user terminal device when the means for identifying the input from the user terminal device identifies that the selection information is entered from the user terminal device.

Systems and software formed in accordance with claim 3 of the present application have many technical and commercial advantages. The workload does not significantly increase on the host computer side when there are many user terminal devices, since the host computer does not itself carry out the selection operation. As set out in claim 3, the user terminal devices execute the selection operations. In addition, since the user of the terminal devices must access the host computer in order to obtain the selection information, it appears to the user who operates the user terminal that the host computer carries out the selection operation and that the selection information is obtained from the host computer. Rather, as set out in the claims, permission to display the selection information is obtained from the host computer but, again, the user terminal device executes the selection operation.

Another commercial and technical advantage of the system in the present application is that the host computer does not fail to obtain the information from the user whenever the selection information is displayed on the user terminal device. Although the host computer does not carry out the selection operation itself, the host computer obtains the information from the user whenever the selection information is displayed on the user terminal device.

In the Office action dated February 13, 2008, the Examiner stated that Hanai generally teaches each feature of claim 3 but does not specifically disclose "a

means for carrying out a selection operation which selects one or more other combined equipment which is different from the service equipment and is suitable for being combined with the service equipment, based on model information and operational conditions of the service equipment entered from the operations section, and the constant data stored in the constant memory means" included on the user terminal. Further, the Examiner further stated that in the embodiment shown in Figures 1 and 4 of Hanai, "...the selection system resides in the server and not in the user terminal." The Examiner, however, stated that "Yankovich discloses processing information on the client side of a client-server system (paragraph 69) for the purpose of reducing the load on the server." Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention "to modify Hanai by performing the processing (selection system) on the client side as taught by Yankovich for the purpose of reducing server load." The Examiner further stated that, "Yankovich teaches that by doing so the system may support a greater number of clients (paragraph 69)."

Applicant respectfully submits that there must be a basis for combining the references. The determination regarding whether an invention as claimed is obvious in view of the prior art must be made in accordance with the standards set forth in the Supreme Court's opinion in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ , 82 USPQ2d 1385 (2007). The KSR court identified a number of rationales to support a conclusion of obviousness, including the traditional teaching-suggestion-motivation test. Upon reviewing the present Office action, it appears that the Examiner relied on the teaching-suggestion-motivation test in rejecting the claims in the present invention.

Applicant respectfully contends, however, that modifying Hanai with the teachings of Yankovich would render Hanai inoperable for its intended purpose. Applicant respectfully reminds the Examiner that the proposed modification cannot render the prior art unsatisfactory for its intended purpose, or change the principle of operation of a reference (MPEP §2143.01). Specifically, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In *Gordon* the claimed device was a blood filter assembly where both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and a gas vent was located at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils where the inlet and outlet were at the top of the device, and a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The Board concluded the claims were *prima facie* obvious, stating that it would have been obvious to turn the reference device upside down. The Federal Circuit reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

In regards to Hanai, Hanai discloses a sales system connected to the internet 2 for communication with client terminals 31. The sales system includes an in-house network system 1 that includes multiple store terminals 11, multiple store DB's 21, a management server 13, a management DB 23, a shopping server 15, and a

shopping DB 25. The store terminals 11 are located in stores such as a sales store and the store DB's 21 are used to process the business operations of the stores. Further, the shopping server 15 and the shopping DB 25 are systems for processing shopping via the internet 2.

As shown in FIG. 6, the shopping DB 25 includes multiple DB's, such as, a member DB 251, that contains client membership information, item material DB 252 that includes items for online shopping, etc. When the client wishes to shop online the terminals 31 communicate with the shopping server 15 and the shopping DB 25 via the internet 2. In Hanai, the client terminals 31 correspond to the user terminal device in the present invention and the shopping server 15 corresponds to the host computer device in the present application. Paragraphs [0090]-[0111] of Hanai, describe the online shopping process. As explained in these paragraphs the selection operation is obviously carried out by the shopping server 15, which, as mentioned above, corresponds to the host computer in the present application. The shopping server 15 then transmits the selection information to the client terminal 31. The selection operation must be carried out by the shopping server 15 in Hanai because the shopping DB 25 that contains client, item, and other information necessary for online shopping is located on the host side of the system. If the client cannot access the shopping DB 25 then the client cannot shop online.

Thus, if Hanai were modified with the teachings of Yankovich to locate the processing (selection system) on the client side, as suggested by the Examiner, the modification would render Hanai unsatisfactory for its intended purpose. As mentioned above, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or

motivation to make the proposed modification." *Id.*

As a result, there would be no motivation for one skilled in the art to seek out the teachings of Yankovich to modify Hanai. Thus, the Examiner improperly combined Hanai with the teachings of Yankovich and has therefore, failed to establish a prima facie case of obviousness.

In addition, Applicant respectfully submits that even if Hanai was modified in the manner suggested by the Examiner, Hanai would still not teach all the features of claim 3. More specifically, Hanai does not teach "a means for requesting a display permission from said host computer for displaying said selection information ...or displaying said selection information onto said display section..." Here the Examiner has attempted to interpret a "log-in" as a display permission request. The underlying item, however, to be displayed in the event that the display permission is granted is wholly lacking in Hanai.

With reference to claims 6 and 9, claims 6 and 9 include similar features as claim 3. Thus, all arguments pertaining to claim 3 are equally applicable to claims 6 and 9.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NIS-16015.

Respectfully submitted,

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